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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/855,107 | 05/14/2001 | Fujio Tanaka | 1217-010689 | 8727 |

7590 . 10/22/2003

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Pittsburgh, PA 15219-1818

EXAMINER

LANGEL, WAYNE A

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| ART UNIT | PAPER NUMBER |
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1754

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

855107

Applicant(s)

Tanaka et al

Examiner

Langel

Group Art Unit

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— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 8-25-03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-26 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 2, 6, 13, 14 and 16 is/are allowed.
- ☒ Claim(s) 1, 3-5, 7-12, 15 and 17-26 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 10
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 5, 8-12, 18 and 20-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ledon et al. '947 in view of Sugihara et al. '179 or Kajiwara et al. '487 or Kajiwara et al. '238, for the reasons given in the last Office action. Applicant's argument, that if claim 1 of the present invention was rewritten to describe the sequence in the same manner as Ledon et al. '947, the sequence would be CEA AEA CEA, is not convincing, since such sequence is not excluded by the sequence AEA CEA AEA CEA, as disclosed by Ledon et al. '947, since the ion exchange resin of Ledon et al. '947 would "consist of" a three-step ion exchange resin of a cation exchange resin, an anion exchange resin in the carbonate ion or bicarbonate ion form, and another cation exchange resin after the initial anion exchange resin shown in the sequence at column 2, line 26 of Ledon et al. '947. In other words, the "three-step ion exchange resin consisting of the three resins as recited in applicant's

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claim 1 would not exclude the sequence disclosed at column 2, lines 25 and 26 of Ledon et al. '947, since the ion exchange resin of Ledon et al. '947 would also "consist of" the same three ion exchange resins after the initial anion exchange resin. Applicant's arguments, as to what Sugihara et al. '179, Kajiwara et al. '238 and Kajiwara et al. '487 disclose or do not disclose, are not convincing, since the secondary references are merely relied upon to disclose that it is known to purify aqueous hydrogen peroxide solutions by passing the solution through a strongly acidic cation exchange resin in the hydrogen form. Applicant's argument, that none of the references disclose the filter pore size recited in claims 9 and 12, along with the results in steps of the present invention, is not convincing. Ledon et al. '947 disclose in the paragraph bridging columns 2 and 3 that the process may comprise filtration, ultrafiltration or nanofiltration upstream of the sequences for passing the solution to be purified through the beds of ion-exchange adsorbents. It would be within the skill of one of ordinary skill in the art to determine a suitable or optimum pore size for the filter in such filtration steps.

Claims 3, 7, 15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ledon et al. '947 in view of Sugihara et al. '179 or Kajiwara et al. '487 or Kajiwara et al. '238 as applied to claim 1 above, and further in view of

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either Saito et al. or Nishide et al., for the reasons given in the last Office action. Applicant's argument, that Saito et al. and Nishide et al. do not disclose or suggest the specific sequence of the ion exchange resins in the present invention, is not convincing, since Saito et al. and Nishide et al. are relied upon merely to show that it is known to contact an aqueous hydrogen peroxide solution with an adsorption resin before contacting with the hydrogen cation exchange resin of Ledon et al. '947.

Claims 2, 6, 13, 14 and 16 are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne A. Langel whose telephone number is (703) 308-0248. The examiner can normally be reached on Monday through Friday from 8 A.M. to 3:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on (703) 308-3837. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

WAL:cdc

October 14, 2003


WAYNE A. LANGEL
PRIMARY EXAMINER